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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,632	07/19/2001	Michael L. Naughton	7054-2	9976

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EXAMINER

ALAVI, ALI

ART UNIT PAPER NUMBER

2875

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,632

Applicant(s)

NAUGHTON, MICHAEL L.

Examiner

Ali Alavi

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-20 is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 5, recites "...wherein the user can align and orient the beam of light by manipulating the positioning of the handle.." it is indefinite because It is unclear which beam of light is being aligned since there is only one beam of light is cited in the claim. There should be two light beams in order to align one to another (i.e., one surgical light that generates the general illumination and another light source which is the light handle and producing a directed beam of light to a surgical area.)

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu (US Pat. No 6,056,414).

Regarding claims 1-4, 6-8, and 9, a surgical light handle especially adapted for delivering a directed beam of light to a surgical area (the preamble has not given

patentable weight because surgical area has not been brought into the body of the claim). It has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self contained description of the structure not depending for completeness upon the introductory clause. See *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951). Liu discloses a light handle including a handle portion (16, fig. 1) for grasping by a user (handheld, col. 1, line 4), a source of light integral with said handle (20, fig. 1) for producing the directed beam of light (see fig. 1), wherein the user can align and orient the beam of light by manipulating the positioning of the handle portion (see fig. 1, abstract), and power source (col. 3, lines 64-67) integral with said light handle for powering said source of light, wherein said handle is cylindrical shaped (16, fig. 1), wherein said source of light is disposed near a distal end (20, fig. 1), means attached to said handle portion for activating and deactivating the source of light (24, fig. 1), wherein said power source includes a battery disposed within said handle portion and electrically communicating with said light source (col. 3, lines 64-67).

Claims 10-12, are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu (US Pat. No 6,056,414) in view of Wiggins (US Pat. No 6,149,286).

Regarding claims 10-12, Liu discloses the claimed invention as applied above in claim 1 except for the micro switch and the laser light source. On the other hand, Wiggins discloses a laser fishing rod including a handle having a laser light source (30, fig. 2), a micro switch (37, figs. 2 & 5, col. 3, 33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the light source of Liu

with a the laser diode of Wiggins in order to direct the laser beam to any desired spot in a noticeable manner as taught by Wiggins.

Allowable Subject Matter

3. Claims 5, 13-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Claim 5 in part recites “..an illuminating light for illuminating the surgical area, and means for attaching the light handle to said illuminating light.” This limitation in combination with the light handle was not found in the prior art of record.

4. Claims 15-20 are allowed.

The following is an examiner's statement of reasons for allowance: The prior art of record failed to teach or suggest a method of orienting an illuminating light on a work area including the step of providing an illuminating producing a light pattern for illuminating an work area, attaching a means to the illuminating light for orienting the illumination light to project light to a desired location within the work area, incorporating a light source producing a directed beam of light within said means for orienting, the directed beam of light being differentiated from the light produced by the illuminating light, and manipulating the means for orienting to direct the directed the directed beam of light to the desired location within the work area thus orienting the light pattern of the illuminating light.

Claim 19 is allowable because in part recites “..a source of light producing the directed beam of light mounted within said handle portion, wherein manipulating the

Art Unit: 2875

handle portion to project the directed beam of light on a target within the work area
orients the illuminating light on the work area, and a power source integral with said
handle portion for powering said source of light." The prior art failed to show or teach a
combination of a light handle and an illuminating light as recited in claim 19.

Any comments considered necessary by applicant must be submitted no later
than the payment of the issue fee and, to avoid processing delays, should preferably
accompany the issue fee. Such submissions should be clearly labeled "Comments on
Statement of Reasons for Allowance."

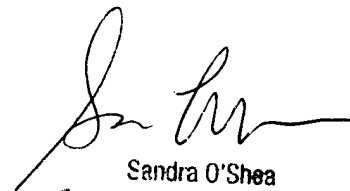
Conclusion

5. The prior art made of record and not relied upon is considered pertinent to
applicant's disclosure. Krieger (US Pat. No 6,056,414) discloses a portable light
including a handle and a light source therein with a switch.

6. Any inquiry concerning this communication or earlier communication from the
examiner should be directed to Ali Alavi whose telephone number is (703) 305-0522.
The examiner can normally be reached between 8:00 A.M. to 4:30 P.M. Monday to
Friday. If attempts to reach the examiner by phone are unsuccessful, the examiner's
supervisor, Sandy O'Shea can be reached at (703) 305-4939 or you may fax your
inquiry to the receptionist at (703) 308-7382.

Ali Alavi

8/09/02


Sandra O'Shea
Supervisory Patent Examiner
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